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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/800,340

03/12/2004

Lee Weng

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06/10/2009

JONES DAY
222 EAST 41ST ST
NEW YORK, NY 10017

EXAMINER

RIGGS II, LARRY D

ART UNIT

PAPER NUMBER

1631

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/800,340	Applicant(s) WENG, LEE	
	Examiner LARRY D. RIGGS II	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 20-59 and 66-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20-57, 66, 67 and 70 is/are rejected.
- 7) ☒ Claim(s) 58, 59, 68 and 69 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's amendments filed 02 February 2009 are acknowledged and entered.

Status of Claims

Claim 19 and 60-65 are cancelled. Claims 1-18, 20-59 and 66-70 are currently pending and examined on the merits.

Withdrawn Rejections/Objections

The rejection of claims 58, 59, 68 and 69 under 35 U.S.C. 101, in the Office action mailed 03 October 2008 is withdrawn in view of the arguments filed 02 February 2009.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

This rejection is maintained and reiterated in-part from the previous office action, mailed 03 October 2008.

Claims 1-18, 20-57, 66, 67 and 70 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The instant claims 1-18, 20-57, 66, 67 and 70 are drawn to a method for generating at least one error-corrected experiment profile of at least one experiment profile in a plurality of pairs of profiles.

The instant claims are drawn to a method of selecting variable threshold parameters to be utilized in a report to assist a patient in diabetes therapy management. The instant claims are drawn to the abstract process steps of calculating an average reference profile, determining a differential reference profile, adjusting an experimental profile and outputting an experiment-corrected profile.

The Supreme Court has enunciated a definitive test to determine whether a process claim is tailored narrowly enough to encompass only a particular application of a fundamental principle rather than to pre-empt the principle itself. A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See *in re Bilski* 88 USPQ2d 1385 (Fed. Cir. 2008) and *in re Comiskey* 89 USPQ2d 1655 (Fed. Cir. 2009). See also *Benson*, 409 U.S. at 70; *Diehr*, 450 U.S. at 192; see also *Flook*, 437 U.S. at 589 n.9; *Cochrane v. Deener*, 94 U.S. 780, 788 (1876).

The instant claims do not recite or inherently involve any transformation of an article, therefore the Examiner must determine if the instant claims have a tie to a particular machine or apparatus. The instant claims do not recite any limitation that ties the recited abstract process to any particular machine or apparatus. Reciting each step “on a computer” is not a tie to a particular machine or apparatus but a general purpose computer. Likewise, outputting or displaying an experiment-corrected profile is an insignificant extra-solution activity. Nominal or token recitations will not suffice, E.g. displaying, inputting, obtaining, See *Ex parte Langemyr* (May 28, 2008). Applicants are cautioned against introduction of new matter in an amendment.

Response to Arguments

Applicant's arguments filed 02 February 2009 have been fully considered but only persuasive in part.

Applicants argue that reciting "on a computer" suffices for a particular machine or apparatus recited in the machine or transformation test cited In re Bilski.

Applicants argue that because the specification did not contemplate a carrier wave or signal to encompass a computer readable medium, that the instant claims should not be construed as such.

Applicant's arguments are convincing in part.

The instant method claims 1-18, 20-57, 66, 67 and 70 are not tied to a particular machine or apparatus as shown above. The specification only recites a general purpose computer performing the method as a whole, (page 57, lines 15-22) or a computer accepting/retrieving/storing data (page 59, lines 17-27). However, nothing about a computer "calculating/determining/adjusting" as cited in steps a-c of instant claim 1.

The instant claims 59 and 69 recite a computer program product with a computer readable storage medium. The instant claims are construed as a recordable storage medium that would not encompass a transient signal or carrier wave. Likewise, instant claims 58 and 68 are drawn to a system which is not applicable to the machine or transformation test.

Allowable Subject Matter

Claims 58, 59, 68 and 69 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LARRY D. RIGGS II whose telephone number is (571)270-3062. The examiner can normally be reached on Monday-Thursday, 7:30AM-5:00PM, ALT. Friday, EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie Moran can be reached on 571-272-0720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ERIC S. DEJONG/
Examiner, Art Unit 1631

/LDR/
Larry Riggs
Examiner, Art Unit 1631